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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/644,431	08/20/2003	Herman D. D'Hooge	ITL.0415DIUS (P6930D)	6993

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TROP, PRUNER & HU, P.C.
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EXAMINER

NGUYEN, THONG Q

ART UNIT	PAPER NUMBER
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2872

DATE MAILED: 02/24/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

H.A

Office Action Summary

Application No.

10/644,431

Applicant(s)

D'HOOGE ET AL.

Examiner

Thong Q. Nguyen

Art Unit

2872

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 29 November 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 18-25 is/are pending in the application.
- 4a) Of the above claim(s) 22-24 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 18-20 and 25 is/are rejected.
- 7) ☒ Claim(s) 21 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Election/Restrictions

1. Applicant's election with traverse of Invention I, claims 18-21 and 25, in the reply filed on Nov. 29, 2004 is acknowledged. The traversal is on the ground(s) that the method of claim 18, invention I, and the instructions of claim 22, invention II, are related and the examiner has failed to establish that distinct inventions are claimed. See Election, pages 2-3. This is not found persuasive because of the following reason(s).

The claims 22-24 are directed to an article comprising a medium storing instructions that enable a processor-based system while the claims 18-21 and 25 are directed to a method or a microscope having elements/steps of controlling the color balance of an imaging unit based on the light source(s), the quality of a captured image, etc... As clearly stated by the Examiner in the previous Office action of 10/27/2004, page 2-3, element 3), the step of operating the microscope as recited in the Invention I could be written/executed in papers or oral communication. In other words, an operator can execute the method by reading the instruction from a set of papers or a textbook or from the conversation with a trainer. (s)he does not need to have any processor-based element/system for operating a microscope as required by the elements/components recited in the invention II.

In response to the applicant's arguments that the reason provided by the Examiner does not have any support, applicant is respectfully invited to review the U.S. Patent Nos. 6,432,852 (column 5, lines 7+) and 6,372,498 (column 5, lines 52+) which shows that the instructions for performing/executing a method can be written in papers.

The requirement is still deemed proper and is therefore made FINAL.

Drawings

2. The drawings contain thirty-three sheets of figures 1-33 were received on 10/01/2001. These drawings are approved by the Examiner.

Specification

3. The lengthy specification has not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification.

4. The disclosure is objected to because it does not have the section of the "Summary of the Invention". Further, the specification should be amended to update the status of the copending applications listed in page 1 of the specification. Applicant should note that the copending application, serial number 09/568,391, is now U.S. patent No. 6,636,354 and the copending application, serial number 09/474,380 is now abandoned. Appropriate correction is required.

The following guidelines illustrate the preferred layout for the specification of a utility application. These guidelines are suggested for the applicant's use.

Arrangement of the Specification

As provided in 37 CFR 1.77(b), the specification of a utility application should include the following sections in order. Each of the lettered items should appear in upper case, without underlining or bold type, as a section heading. If no text follows the section heading, the phrase "Not Applicable" should follow the section heading:

- (a) TITLE OF THE INVENTION.
- (b) CROSS-REFERENCE TO RELATED APPLICATIONS.

- (c) STATEMENT REGARDING FEDERALLY SPONSORED RESEARCH OR DEVELOPMENT.
- (d) INCORPORATION-BY-REFERENCE OF MATERIAL SUBMITTED ON A COMPACT DISC (See 37 CFR 1.52(e)(5) and MPEP 608.05. Computer program listings (37 CFR 1.96(c)), "Sequence Listings" (37 CFR 1.821(c)), and tables having more than 50 pages of text are permitted to be submitted on compact discs.) or REFERENCE TO A "MICROFICHE APPENDIX" (See MPEP § 608.05(a). "Microfiche Appendices" were accepted by the Office until March 1, 2001.)
- (e) BACKGROUND OF THE INVENTION.
 - (1) Field of the Invention.
 - (2) Description of Related Art including information disclosed under 37 CFR 1.97 and 1.98.
- (f) BRIEF SUMMARY OF THE INVENTION.
- (g) BRIEF DESCRIPTION OF THE SEVERAL VIEWS OF THE DRAWING(S).
- (h) DETAILED DESCRIPTION OF THE INVENTION.
- (i) CLAIM OR CLAIMS (commencing on a separate sheet).
- (j) ABSTRACT OF THE DISCLOSURE (commencing on a separate sheet).
- (k) SEQUENCE LISTING (See MPEP § 2424 and 37 CFR 1.821-1.825. A "Sequence Listing" is required on paper if the application discloses a nucleotide or amino acid sequence as defined in 37 CFR 1.821(a) and if the required "Sequence Listing" is not submitted as an electronic document on compact disc).

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 18 and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Leiter (U.S. Patent No. 5,022,744).

Leiter discloses a microscope having an illuminating system and a color temperature regulating system. The microscope as described in columns 2-4 and shown in figs. 1-3 comprises a microscope (1) for supporting a color temperature

measurement system (14), a detecting system having camera (13); an illuminating system (2); a color temperature regulating system (4). The light from the illuminating system illuminates a sample and its image is received by the color temperature measurement system having two filters (17, 18) and two sensing elements (19, 20). The outputs from the sensing elements (19, 20) are guided to a control device (23) which controls a carrier 96) for inserting or moving a particular filter (7, 8) into the illuminating path for the purpose of balancing the color of the image received by the color temperature measurement system. It is noted that the presence of the filter (7) or (8) is detected and the light passing through the current used filter in the illuminating path is continuously measured and the position of the filter is varied under the operation of the control device for the purpose of balancing the color of the image. See column 2.

The only feature missing from the microscope provided by Leiter is that he does not clearly set forth a method or a set of steps for using his microscope; however, it would have been obvious to one skilled in the art at the time the invention was made to set forth a set of steps including the step of detecting whether the light of the illuminating system is ON or OFF, and then receiving the image of an objected illuminated by the illuminating system and then using the color temperature measurement system for capturing and for analyzing the image and then adjusting the color of the image based on the operation of the color temperature regulating system and the control system for the purpose of observing an image with better quality.

7. Claims 18 and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bawolek (U.S. Patent No. 6,055,095).

Bawolek discloses a microscope having an illuminating system and an image unit for receiving and analyzing the image of an object illuminated by the illuminating system. The microscope as described in columns 1-3 and shown in figs. 1-4 comprises the following structures: An illuminating system having two light sources (40, 42) whose operation is controlled by an interface (44) or a switch (23) wherein one of the light source is ON while the other is OFF based on a particular illumination pattern; an image unit having digital elements for receiving the image of an object (38) illuminated by a particular light source wherein the output of the image unit is guided to a computer system for the purpose of analyzing the optical feature of the object. It is noted that the color of the image unit is adjusted via a system having computer and mouse for the purpose of balancing the color. See column 3.

The only feature missing from the microscope provided by Bawolek is that he does not clearly set forth a method or a set of steps for using his microscope; however, it would have been obvious to one skilled in the art at the time the invention was made to set forth a set of steps including the step of detecting whether the light of each of the light sources constituting the illuminating system is ON or OFF, and then receiving the image of an object illuminated by a particular light source of the illuminating system and then using the image unit connected to a computer for capturing and for analyzing the image and then

adjusting the color of the image based on the operation of the computer and its mouse for the purpose of observing an image with better quality.

8. Claim 25 is rejected under 35 U.S.C. 103(a) as being unpatentable over Bawolek in view of Seok et al (U.S. Patent No. 5,909,950).

Bawolek discloses a microscope having an illuminating system and an image unit for receiving and analyzing the image of an object illuminated by the illuminating system. The microscope as described in columns 1-3 and shown in figs. 1-4 comprises the following structures: An illuminating system having two light sources (40, 42) whose operation is controlled by an interface (44) or a switch (23) wherein one of the light source is ON while the other is OFF based on a particular illumination pattern; an image unit having digital elements for receiving the image of an object (38) illuminated by a particular light source wherein the output of the image unit is guided to a computer system for the purpose of analyzing the optical feature of the object. It is noted that the color of the image unit is adjusted via a system having computer and mouse for the purpose of balancing the color. See column 3.

The only feature missing from the microscope provided by Bawolek is that he does not clearly disclose the use of a detector for detecting the ON or OFF state of a light source. However, the use of a switching system having a detector for detecting whether a light source is ON or OFF is known to one skilled in the art as can be seen in the switching system provided by Seok et al. In particular, Seok et al disclose a switching system connecting to a light source and a

detector wherein the detector is used to show the status of the light source on the basis of a switching operation. See columns 1-3. Thus, it would have been obvious to one skilled in the art at the time the invention was made to utilize a switching system having a detector for detecting the status of a light source as suggested by Seok et al for the purpose of informing a user the ON or OFF status of a light source in a system to avoid the confusion to a user of a system in use.

Allowable Subject Matter

9. Claim 21 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.
10. The following is a statement of reasons for the indication of allowable subject matter:

The method as claimed in claim 21 is patentable with respect to the cited art by the limitations related to the detecting of two light sources which are arranged in the image unit and in the base removably supporting the image unit. While the use of a microscope having a base for removably supporting an image unit is known to one skilled in the art; however, the cited art does not disclose a method for detecting the on/off state of a first light source associated with an image unit and a second light source associated with a base removably supporting the image unit which method comprises the step of setting a color balance of the

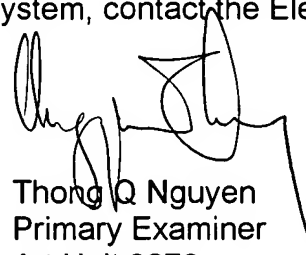
imaging unit based on the analysis of the image, the on/off of at least one light source and the nature of the light as claimed.

Conclusion

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thong Q. Nguyen whose telephone number is (571) 272-2316. The examiner can normally be reached on M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Drew A. Dunn can be reached on (571) 272-2312. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Thong Q. Nguyen
Primary Examiner
Art Unit 2872
